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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/649,703	08/28/2003	Cynthia L. Ebner	D-43574-01	6771
7590 01/26/2005			EXAMINER	
Howard Troffkin 7808 Ivymount Terrace Potomac, MD 20854			RAYFORD, SANDRA M	
			ART UNIT	PAPER NUMBER
			1772	

DATE MAILED: 01/26/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/649,703

Applicant(s)

EBNER ET AL.

Examiner

Sandra M. Nolan

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 04 November 2004.  
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-24 is/are pending in the application.  
4a) Of the above claim(s) 6-24 is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1-5 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.  
10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 10-5-04.  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.  
5) ☐ Notice of Informal Patent Application (PTO-152)  
6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Claims***

1. Claims 1-24 are pending. Claims 6-24 have been withdrawn as non-elected.

The current claims are recited on pages 8-17 of the Arguments section of applicants' response in the eDAN/IDS file (i.e., in the arguments section of the 11-4-04 response).

### ***Information Disclosure Statement***

2. The information disclosure statement (IDS) submitted on 05 October 2004 was considered by the examiner.

### ***Election/Restrictions***

3. This application contains claims 6-24, drawn to an invention nonelected with traverse in the response dated 04 November 2004 ("the last response").

On page 3 of the last response, applicants confirmed their election of the invention of claims 1-5 (Group I) and the following species: (A) tetrahydrophthalic anhydride, (B) hexane diol, (C) trimethylol-propane, and (D) isophthalic acid.

4. A complete reply to any final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.
5. The restriction requirement is made **final**.

### ***Rejections Withdrawn***

6. The 35 USC 102 rejection of claims 1-5 as anticipated by Bowles (US 6,187,444) is withdrawn in view of the persuasive arguments presented on pages 5-8 of the last response.

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7. The 35 USC 103 rejection of claims 1-5 as unpatentable over Bowles in view of Chu (US 4,720,356) is withdrawn in view of the persuasive arguments presented on pages 5-9 of the last response.

### ***New Rejections***

#### **Double Patenting**

8. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

9. Claims 1-5 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-5 of copending application SN. 10/649,739.

At this writing, the '739 application has been allowed.

Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the '739 application cover films containing transition metal salts and polymers derived from applicants' compound A and one or more polyfunctional compounds having the structure  $G-R'(-G)_x$ , with R' being a non-aromatic or aromatic hydrocarbon group, G being a functional group and x being 1 or

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more. In claims 4 and 5 of the '739 application, G is defined as acid, acid halide, hydroxyl or amino.

The '739 application recites an additional cationic compound not called for in the instant claims. However, applicants' films "comprise" the components recited therein, so that the cationic compound of the '739 claims could be present.

Also, it would have been obvious to render the films of the '739 application less expensive to produce by eliminating the cationic compounds.

10. Claims 1-5 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-8 of copending Application No. 10/649,747. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the '747 application cover films containing applicants' component A with (i) one or more polyfunctional compounds having the structure  $G-R'(-G)_x$ , with  $R'$  being a non-aromatic or aromatic hydrocarbon group,  $G$  being a functional group and  $x$  being 1 or more and (ii) a prepolymer  $P-(J)_p$ , with  $J$  being a  $C=OD$  group with  $D$  defined as  $OH$  or  $OR$  (see claim 2 of the '747 application). In claim 4 of the '747 application,  $C_{2-20}$  diols are recited.

The presence of one or more  $G-R'(-G)_x$  and  $P-(J)_p$  compounds makes the use of applicants' components (B) and (C) obvious.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

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***Response to Arguments***

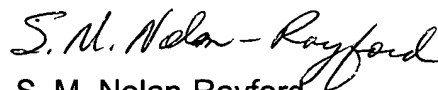
11. Applicant's arguments with respect to claims 1-5 have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

Any inquiry concerning this communication should be addressed to Sandra M. Nolan-Rayford, at telephone number 571/272-1495. She can normally be reached Monday through Thursday, from 6:30 am to 4:00 pm, Eastern Time.

If attempts to reach the examiner are unsuccessful, her supervisor, Harold Pyon, can be reached at 571/272-1498.

The fax number for patent application documents is 703/872-9306.



S. M. Nolan-Rayford  
Primary Examiner  
Technology Center 1700

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